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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/259,413	06/14/94	HARRIS	J SYNE210C

HM12/1210

U.S. PATENT OPERATION
DEPARTMENT 430, M/S 27-4-A
AMGEN INCORPORATED
ONE AMGEN CENTER DRIVE
THOUSAND OAKS CA 91320-1799

EXAMINER

LILLING, H

ART UNIT PAPER NUMBER

1651

27

DATE MAILED: 12/10/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10-29-99 12-8-99 PAR

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1835 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☐ Claim(s) 15 45-58 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 15 45-58 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 20 (9 pages)

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Serial 08/259413

1. Receipt is acknowledged of the election and the fax of December 08, 1999.

2. Claims 15 and 45-58 are present in the instant application.

Claims 1-14 and 16-44 were previously cancelled in Paper No. 15 dated December 12, 1998.

3. Applicant has elected the species polyethylene glycol as the difunctional polymeric grouping.

4. Claims 15 and 45-47 and 50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of copending Application No.08/482,283. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are within the scope of the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418

F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than sssone year prior to the date of application for patent in the United States.

Claims 15 and 45-58 are rejected under 35 U.S.C. 102() as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Armes et al WO9216221.

Applicant has indicated that both of the priority documents clearly supports claimed 15 in the instant application as submitted in the fax of pages of 07/850,675 dated December 08, 1999. However, both of the priority documents 07/850,675 and 07/669,862 were abandoned prior to the filing of this instant applicatidon. There is a hiatus in the line of priority which prevents this Examiner to remove the above rejection. There are pending applications which may have a line of priority cases to support the instant claims but this line of priority fails to have

the continued support.

6. No claim is allowed.

5 7. Any inquiry concerning this communication or earlier
communications from the examiner should be directed to Examiner
Lilling whose telephone number is (703) 308-2034 and fax number
(Art Unit 1651) is (703) 305-7939 or SPE Michael Wityshyn whose
telephone number is (703) 308-4743. Any inquiry of a general
10 nature or relating to the status of this application should be
directed to the Group receptionist whose telephone number is (703)
308-0196.

15 H.J.Lilling: HJL
(703) 308-2034
Art Unit 1651
December 09, 1999

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HERBERT J. LILLING
PATENT EXAMINER
GROUP 1600 ART UNIT 1651